

REMARKS

Claims 1-34 are pending in the present application. No amendments to the claims are made by this Response. Reconsideration of the claims is respectfully requested.

I. Attempted Telephone Interview

Applicants' representative attempted to contact the Examiner and his Supervisor via telephone on December 17 and 31, 2003 to discuss the rejections in the Office Action but had to leave voicemail messages due to the Examiner and his Supervisor not being available. However, neither the Examiner nor his Supervisor returned the calls prior to the Response due date. Thus, Applicants respectfully request that either the Examiner or his Supervisor contact Applicants' undersigned representative in order to conduct a telephone interview upon receipt of this Response.

II. 35 U.S.C. § 112, Claims 1-34

The Examiner rejects claims 1-34 under 35 U.S.C. § 112 as unclear in regard to the disclosure. The Office Action states:

Claims 1-34 recite six independent/dependent claim sets apparently drafted to cover one or more portions or one or more multiple combinations and subcombinations of the drawing. The correlation is not clear. There appear to be multiple inventions. Read each claim term by term on the drawing and discuss the meaning intent and patentable significance thereof.

Office Action dated October 7, 2003, page 4.

Applicants respectfully submit that the above rejection under 35 U.S.C. § 112 as stated in the Office Action is improper. First, the Office Action fails to state what paragraph of 35 U.S.C. § 112 the claims are being rejected under. Second, the Office Action fails to set forth a proper basis for a rejection under any of the paragraphs of 35 U.S.C. § 112.

In accordance with the MPEP, an Office Action must set forth the appropriate paragraph of 35 U.S.C. § 112 under which the claims are being rejected and provide a basis upon which the rejection is being made. The current Office Action does not state

which paragraph of 35 U.S.C. § 112 the claims are allegedly being rejected under. Moreover, the alleged basis for the rejection is not based on any requirement set forth in 35 U.S.C. § 112, as discussed hereafter. Thus, the rejection is improper both in its form and its content.

The alleged basis for the rejection is that multiple inventions allegedly exist in the claims. This is not a proper basis for rejecting the claims under 35 U.S.C. § 112. The first paragraph of 35 U.S.C. § 112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The Office Action has not alleged that the specification is not written in full, clear, concise and exact terms such that one of skill in the art would make and use the invention. Moreover, the Office Action has not alleged that the best mode has not been set forth. Rather, the Office Action merely states that there are multiple inventions. Even if there are multiple inventions, there is no prohibition under 35 U.S.C. § 112 against multiple inventions being described in the specification. All that is required is that the inventions that are claimed be described in such a way as to enable one skilled in the art to make and use the invention and that the best mode be set forth.

The second paragraph of 35 U.S.C. § 112 states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the application regards as his invention.

Applicants respectfully submit that the specification of the present application concludes with a plurality of claims that particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Furthermore, the Office Action does not allege that the claims are indefinite. To the contrary, the Office Action merely states that there are multiple inventions. Even if this were the case, simply because there

are multiple inventions does not mean that Applicants have not particularly pointed out or distinctly claimed the subject matter that they regard as the invention. Rather, it merely means that a restriction requirement would be in order if there truly are multiple inventions claimed. The Office Action has not set forth a restriction requirement.

Thus, Applicants respectfully submit that the rejection of claims 1-34 is improper both in form and content. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-34 under 35 U.S.C. § 112.

III. 35 U.S.C. § 102/103, Claims 1-34

The Examiner rejects claims 1-34 under 35 U.S.C. § 102/103 on an "as understood" basis as the disclosure and claims allegedly appear to be drafted to a tape storage with calibration. The Office Action then merely states to see Figure 1 of "each cited reference." This rejection is improper.

Applicants respectfully submit that the Office Action has failed to establish its burden of clearly identifying where in the references each feature of all of claims 1-34 are allegedly taught or suggested. In fact, the Office Action fails to positively identify so much as a single reference and merely refers to Figure 1 of "each cited reference." The Office Action further fails to address so much as a single feature of any of the claims and merely generalizes all of the claims as being "drafted to a tape storage with calibration." This shows a clear lack of consideration of the specific features recited in the claims.

37 CFR 1.104(c)(2) clearly states:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the application, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The references listed in the PTO Form 892 which are apparently the alleged "each cited reference" are Bunch (U.S. Patent No. 5,236,258), Kishi et al. (U.S. Patent No. 5,426,581) and Wilson (U.S. Patent No. 6,213,705). These references each describe

complex tape cartridge data storage library systems and set forth inventions other than that recited in claims 1-34. Thus, the Examiner has not shown what parts of each reference are relied upon as nearly as practicable in rejecting all of claims 1-34 under 102/103. To the contrary, the Office Action merely points to Figure 1 of "each cited reference" without so much as a single comparison of the elements in any Figure 1 of any reference with the features of claims 1-34 of the present application. For example, viewing Figure 1 of Bunch, Ksishi and Wilson, where is there a barcode scanner affixed to a robot, or an attenuation surface affixed to a barcode scanner, wherein the attenuation surface is located such that at least one end of the scan path of the barcode scanner is controlled by the attenuation surface, or a positional encoding device for determining the location of the attenuation surface with respect to a target associated with at least one storage cell? The Examiner has failed to show where any of these features are taught or suggested in Figure 1 of "each cited reference."

Furthermore, as stated in MPEP § 706:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the application has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

The Office Action has failed to achieve this goal since the Office Action fails to show where "each cited reference" either teaches or suggests the features of the claims such that Applicants may provide an adequate response in rebuttal of the Examiner's position. To the contrary, if Applicants were to attempt to respond to "each cited reference," it would amount to the Examiner shifting the burden of establishing a rejection to Applicants since Applicants must guess at what the Examiner believes is taught or suggested and where it is taught or suggested. It is not Applicants' burden to establish a prima facie case of anticipation or obviousness but rather the Examiner's burden. This burden has not been met in the present case.

Applicants further point out that the alleged rejection is under 102/103. However, the Office Action fails to address those features of the claims that the Examiner believes are "inherent" or "obvious" in view of "each cited reference." The Office Action has not

so much as attempted an analysis of the claims and "each cited reference" under 102 or 103 and thus, has not established its burden under either section of 35 U.S.C. To the contrary, the Office Action merely generalizes the invention and fails to even mention one feature in any of the claims. Therefore, the rejection of claims 1-34 under 35 U.S.C. § 102/103 is improper and should be withdrawn.

IV. Conclusion

Applicants respectfully submit that the Office Action has not established any case of anticipation or obviousness of the claims based on any prior art and thus, the application is in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE:

January 7, 2004

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